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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/587,574	06/05/2000	Jurgen Behrens	0107-026P	7952
23622	7590	01/30/2003	EXAMINER	
GABRIEL P. KATONA GOODWIN PROCTER L.L.P. 599 LEXINGTON AVENUE 40TH FLOOR NEW YORK, NY 10022			YU, MISOOK	
		ART UNIT	PAPER NUMBER	
		1642		
DATE MAILED: 01/30/2003				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/587,574	BEHRENS ET AL.
	Examiner	Art Unit
	MISOOK YU, Ph.D.	1642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 12 November 2002.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 24-32 and 35-46 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 33 is/are rejected.

7) Claim(s) 34 is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachments(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____	6) <input type="checkbox"/> Other: _____

The Examiner of your application in the USPTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Examiner Misook Yu.

## DETAILED ACTION

### *Election/Restrictions*

This application contains claims 24-32 and 35-46 drawn to an nonelected invention. A complete reply to the final rejection must include cancelation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claims 24-46 are pending, claims 24-32 and 35-46 remain withdrawn from further consideration because they are drawn to non-elected invention and claims 33 and 34 are examined on merits.

### *Claim Rejections - 35 USC § 112*

Rejection of claims 33 and 34 for not providing enablement for cancer treatment under 35 U.S.C.112, first paragraph is withdrawn since the instant invention is not drawn to cancer treatment method but are drawn to a murine protein applicant named "conductin" and the instant specification provides enough evidence about the function of the protein and how to make and use the protein.

Claim 33 remain rejected for the reasons set forth at Paragraph #9 of the previous Office Action (Paper No. 12) under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant does not argue about this rejection. The claim is drawn to a genus of proteins known as conduction. The specification provides evidence for only one murine species. Based on only one species, one cannot predict the types of additional species such as splicing variants or other species from different organism such as human or donkey. Since the genus includes a large number of unpredictable species, possession of only one

species is not seen as sufficient to reasonably convey possession of the entire genus. It is concluded that applicants adequately describes SEQ ID NO:1, a murine conductin.

### ***NEW GROUNDS OF REJECTION***

#### ***Claim Rejections - 35 USC § 112***

Claims 33 and 34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 33 recites “the same biological activity as conductin” but it is not clear what the metes and bounds are for the limitation. Since the specification at Fig. 4 shows that conductin degrades beta-catenine and interacts with APC, this examiner will assume that the limitation means beta-catenine degradation and APC interacting activities. However, this treatment does not relieve applicant the burden of responding to this office action.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claim 33 is rejected under 35 U.S.C. 102(a) as being anticipated by Zeng et al (July 11, 1997, Cell, vol. 90, pages 181-192) as evidenced by Kishida et al (May 1998, J. Biol. Chem. vol. 273, pages 10823-10826).

Claim 33 is interpreted as any protein or peptide that has “the same biological activity as conductin” i.e. APC binding and beta-catenin degradation activities since neither the claim nor the specification defines what is meant by “variations and mutants”. The claim as written reads on the protein taught by Zeng et al (July 11, 1997, Cell, vol. 90, pages 181-192. Note Fig. 3 and Fig. 7.

***Allowable Subject Matter***

Claim 34 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Further, the fragments of SEQ ID NO:1 at Fig. 4 with beta-catenin degradation and APC binding activities are free of art.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MISOOK YU, Ph.D. whose telephone number is 703-308-2454. The examiner can normally be reached on 8 A.M. to 5:30 P.M., every other Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony C Caputa can be reached on 703-308-3995. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and 703-872-9307 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Misook Yu  
January 21, 2003

*[Handwritten Signature]*  
ANTHONY C. CAPUTA  
CHEMISTRY PATENT EXAMINER  
TECHNOLOGY CENTER 1800